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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,919	05/24/2001	Andrew V. Anderson	42390.P9765	4902

7590

05/23/2003

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/23/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/865,919 .

Applicant(s)

ANDERSON ET AL.

Examiner

Bunjoo Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2001 .
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_ .

### **DETAILED ACTION**

1. This application has been reviewed. Original claims 1-30 are pending, the objections and rejections cited are as stated below.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, 5, 7-9, 13-15, 18, 20-22 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Horvitz et al (US.2003/0046421).

4. As to claims 1 and 14, Horvitz discloses a methodology that is applicable for constructing computer instructions to function as a system for routing messages on priority bases in a computer system, comprising means and steps for: receiving information of an event, (Fig. 1, Fig. 27); determining whether or not the event is of enough importance to the user to contact a first person concerning the event (paragraphs 9, 11, 14-15, 65); and if the event is of enough

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importance to the user, then selecting a first person to contact, selecting a first way to contact the first person, attempting to contact the first person using the first way, and waiting for a period of time for the first person to respond (paragraphs 74-75, 83).

5. As to claims 2 and 15, Horvitz discloses the methodology further comprising: selecting a second way to contact the first person and attempting to contact the first person if the event is of enough importance to the user, the first person has not responded within the period of time, and there is a second way to contact the first person that is acceptable, (Fig. 27; paragraphs 113-115); and selecting a second person to contact and a way to contact the second person if the event of enough importance to the user, the first person has not responded within the period of time, there is not a second way to contact the first person that is acceptable, and there is a way to contact the second person that is acceptable (Fig. 24; paragraph 107).

6. As to claims 5, 7, 18 and 20, Horvitz discloses determining whether importance comprises referring to information concerning the user's preferences, profile; determining appropriate and/or desirable actions should be or how to carry on without contact the designator, e.g., other people can be designated by a user to take actions, restriction by calendar, preventing message by specifying do not disturb in the profile or preference files (paragraphs 10, 70 and 79).

7. As to claims 8, 9, 21 and 22, Horvitz discloses selecting the first way to contact the first person and determining whether or not there is a second way to contact the first person that is acceptable comprises referring to information concerning the first person's preferences for when and how the first person would prefer to be contacted (user-profile facilitates how and when to deliver message, paragraph 68).

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8. As to claims 13 and 25, Horvitz discloses group of communication means consisting of a landline telephone, a mobile telephone, a text-enabled mobile phone, a pager, a text-enabled pager, a computer system capable of conveying text messages, a computer system capable of conveying audio messages, and a computer system capable of conveying video messages (fig 41).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 16 and 26-30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al (US.2003/0046421), as applied to claim 1 above, and further in view of Merchant (US. 6,532,489).

11. As to claims 3 and 16, Horvitz discloses the invention substantially, as claimed, as described, including a concept of determining level of importance of the messages in order to forward the message to second communication means or a second person associated with the communication means. However, Horvitz does not explicitly disclose the determination included comparing the subject of the event to a list of subjects of interest.

In an analogous art, Merchant teaches a message alert system, which included the used of comparing subject to the list of subject of interest, e.g., e-mail sever alerting user based on

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received match some specified importance or profile such as subject line (Col. 3, line 65-Col. 4, line 7).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate a technique of making determination important subjects as suggested by Merchant with Horvitz. Because incorporation such feature, Horvitz would be able to signify and filter messages, preventing junk messages to get to the user.

12. As to claims 26, in addition to discussion in claim 1 rejection above, Horvitz further discloses receiving information concerning at least one activity in a user's schedule, a first way to contact a first person selected by the user, at least one preference of the first person for how the first person is to be contacted, and at least one requirement of the first person (user profile, alternate message routing, assigning other person e-mail or designating other person, paragraphs 9, 11, 14-15, 65, 68, 74-75, 83, 107; Fig. 24).

Horvitz's teaching does not explicitly include subject of the event to a list of subjects of interest as receiving information and using the information for point of contact determination.

In an analogous art, Merchant teaches a message alert system, which includes subject of interest in user profile and comparing subject to the list of subject of interest, e.g., e-mail sever alerting user based on received match some specified importance or profile such as subject line (Col. 3, line 65-Col. 4, line 7). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate detecting importance subject as suggested by Merchant with Horvitz. Because incorporation such feature, Horvitz would be able to signify and filter messages, preventing junk messages to get to the user.

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13. . As to claim 27, Horvitz-Merchant discloses the invention substantially, as claimed, including the feature that allowed users to designate persons and/or communication devices, as described, in claim 26 above. Horvitz does not explicitly disclose selecting a person from a specific group of users, such as, a family member of the user, a friend of the user, an employee of the user, and a coworker of the user.

However, using a system that has readily had other persons selection or designations as taught by Horvitz to select or designate a person from any group of user, including specific group of users as claimed therein, would have been obvious to one ordinary skill in the art at the time of the invention was made that was a matter of design choice. Because, selecting person is merely a matter of assigning communication device to an entity, the system does not know nor concern the entity of the person. Hence, selecting person from specific group is merely a preferable choice, which one may decide on the basis of desirable direction to expand the system utilities.

14. As to claims 28 and 30, Horvitz-Merchant discloses selecting the first way to contact the first person and determining whether or not there is a second way to contact the first person that is acceptable comprises referring to information concerning the first person's preferences for when and how the first person would prefer to be contacted (user-profile facilitates how and when to deliver message, Horvitz paragraph 68).

15. As to claim 29, Horvitz-Merchant discloses group of communication means consisting of a landline telephone, a mobile telephone, a text-enabled mobile phone, a pager, a text-enabled pager, a computer system capable of conveying text messages, a computer system capable of

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conveying audio messages, and a computer system capable of conveying video messages (Horvitz, fig 41).

16. Claims 4, 10, 11, 17 and 23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al (US.2003/0046421), as applied to claim 1 above, and further in view of Tsukamoto et al (US. 5,128,981).

17. As to claims 4, 10, 17 and 23, Horvitz discloses the invention substantially, as claimed, as described, including a concept of determining level of importance of the messages in order to forward the message to second communication means or a second person who associated with the communication means and the calendar utilization for scheduling. However, Horvitz does not explicitly disclose in detail of making determination by comparing the timing of the event to activities in which the user is engaged or will be engaged listed in a calendar, i.e., comparing event schedule. In an analogous art, Tsukamoto teaches a wireless communication system capable of executing integrated applications, including electronic mailing and scheduling. Specifically, in scheduling application, the system includes the use of comparing schedule for determining grade of importance of requests as taking appropriated and/or desirable actions, as clearly exemplified in scheduling meeting (Col. 12, lines 21-29; Col. 13, lines 3-61).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate technique of determining grade of important of request from timing or schedule, as taught by Tsukamoto with Horvitz. Because with minimum modifications one can incorporate such feature with Horvitz's system, which would add an enhance feature in Horvitz system, enables the system to integrate scheduler functionality within. Such add on



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feature would make the system more attractive to customers, thereby, simplifying marketing the system.

18. As to claim 11, Horvitz-Tsukamoto discloses referring to information exceptions to those rules (user-profile allow user to exclude message to be delivered, Horvitz, Fig. 14-16).

19. Claims, 6 and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al (US.2003/0046421).

20. As to claims 6 and 19, Horvitz discloses the invention substantially, as claimed, as described, in claims 1 and 5 above, but does not explicitly include a rule that prohibit other person to take action without contact designator. However, using a system, which readily had capabilities to: determining level of importance messages; designating other persons for taking appropriate actions; designating a second, third and so forth, devices for receiving messages; and setting off an event restriction, in users preference, would have been obvious to one of ordinary skill in the art at the time of the invention was made that was a matter of design choice, which governed by operational requirements. Because, in reality, messages and actions taking have different degree of preferable, for instances, some may require privacy response, or some may required urgency response while the other may require confirmation response, thus setting preferable actions in user preference would make system more intelligent, flexible and capable of responding to client utilities in all operational environments.

21. As to claims 12 and 24, Horvitz discloses the invention substantially, as claimed, including the feature that allowed users to designate persons and/or communication devices, as described, in claim 26 above. Horvitz does not explicitly disclose selecting a person from a

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specific group of users, such as, a family member of the user, a friend of the user, an employee of the user, and a coworker of the user.

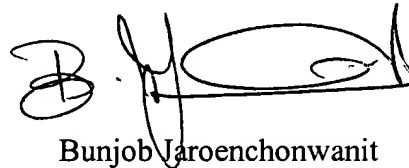
However, using a system that has readily had other persons selection or designations as taught by Horvitz to select or designate a person from any group of user, including specific group of users as claimed therein, would have been obvious to one ordinary skill in the art at the time of the invention was made that was a matter of design choice. Because, selecting person is merely a matter of assigning communication device to an entity, the system does not know nor concern the entity of the person. Hence, selecting person from specific group is merely a preferable choice, which one may decide on the basis of desirable direction to expand the system utilities.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a stylized flourish at the end.

Bunjob Jaroenchonwanit  
Examiner  
Art Unit 2141

/bj  
May 20, 2003